

**REMARKS**

As a result of this amendment claims 1-3, 7, 13-20 are now pending. Claims 1-3, 7, 13-15 have been amended. Claims 17-20 have been added. No new matter has been added to this application by way of amendment.

**PRIORITY**

Regarding the priority, applicants' attorney would like to summarize the priority claims as follows:

I. The declaration filed on July 2, 2002 claims priority to seven documents.

A) Under 119(a)-(d):

101 09 021.8 DE

101 17 803.4 DE

101 40 345.3 DE

102 03 486.9 DE

B) Under 119(e):

60/273,880

60/284,753

60/314,358

II. Regarding submission of foreign priority documents, the following were submitted on their respective dates:

	Date of Submission
101 09 021.8 DE —	2/22/2002
101 17 803.4 DE —	3/22/2002
101 40 345.3 DE 2	3/07/2002
102 03 486.9 DE —	3/22/2002

III. Regarding submission of English Translations, the following were submitted on their respective dates:

	Date of Submission
60/273,880	2/22/2002
60/284,753	2/22/2002
60/314,358	2/22/2002

The English translations of the four German priority documents are submitted herewith in this paper. For the Examiner's convenience, applicants are also submitting again the English of the three US provisionals identified above. It is believed by applicants' attorney that the present application has properly claimed priority under 35 USC 119 (a)-(e). It is respectfully requested of the Examiner to confirm the four certified priority documents: 101 09 021.8 DE; 101 17 803.4 DE; 101 40 345.3 DE and 102 03 486.9 DE have been received. Attached herewith are copies of the return postcards stamped by the Office confirm receipt of these documents.

#### CLAIM REJECTIONS

Claims 1-6, 14-16 have been rejected under 35 USC 102(e) as allegedly being anticipated Chackalamannil.

The amendments to R4 and R20, in the present claims obviate the rejection. Specifically, piperidin-4-yl has been deleted for R20. Withdrawal of the rejection is therefore respectfully requested.

Claims 1-6, 13-16 have been rejected under 35 USC 102(e) as allegedly being anticipated Kanstrup.

The present amendments delete "piperazin-1-yl or [1,4]diazepan-1-yl group" from the definition of R4, thereby obviating the rejection. Withdrawal of the rejection is therefore respectfully requested.

Claim 13 has been rejected under 35 USC 103(a) as allegedly being unpatentable over Chackalamannil.

Since the claims as presently amended are structurally distinct over those disclosed in the reference, the reference neither teaches nor suggests their physiologically acceptable salts forms with inorganic or organic acids or bases. Withdrawal of the rejection is therefore respectfully requested.

Claims 1 and 14 have been rejected under 35 USC 103(a) as allegedly being unpatentable over JP 37-4895. This rejection is traversed.

JP 37-4895 neither teaches nor suggests, alone or in combination with any other prior art, Applicants' novel compounds. Applicants contend that a prima facie case of structural obviousness for all compounds where R4 is an amino group substituted by R<sup>15</sup> and R<sup>16</sup> in the claims has not been made out. However, solely to further prosecution in the case, enclosed herewith is the Declaration of Frank Himmelsbach.

In the Declaration, it can be seen that the compounds disclosed in JP 37-4895 and US 2,928,833 (structurally similar to those in JP 37-4895) which are structurally closest to those of the claimed invention cannot be made by the methods described in their respective disclosures. The CCPA has held in *In re Payne* that references relied upon to support a rejection under 35 USC 103 must provide an enabling disclosure and therefore place the claimed invention in the possession of the public. *In re Payne* 203USPQ 245 at 255, see also *Beckman Instruments, Inc., v. LKB Produkter AB* 13 U.S.P.Q.2D (BNA) 1301 (CAFC 1989). The court in *In re Payne* further stated that the presumption of obviousness based on close structural similarity is overcome where the prior art does not disclose or render obvious a method of making the claimed compound. *Id* at 255. In the present case, neither JP 37-4895 nor US 2,928,833 enable synthetic methods of making the compounds in their own disclosures, and therefore they are not enabling for the instant compounds.

Accordingly, the claimed invention is believed to be unobvious from the prior art of record, and therefore withdrawal of the rejection under 35 USC § 103 is respectfully requested.

Claims 1-6 and 12-16 have been rejected under 35 USC 112 paragraphs 1 and 2.


The claim language "as well as the derivatives which are N-oxidised or methylated or ethylated at the cyclic nitrogen atom in the 9 position of the xanthine skeleton" has been deleted from the claims. It is therefore believed the claims are in compliance with 35 USC 112 paragraphs 1 and 2. Withdrawal of the rejection is respectfully requested.

Claim 15 has been rejected under 35 USC 112 second paragraph. This rejection is traversed in-part.

Claim 15 has been amended to delete 'allograft transplantation' from the list of diseases. This term is in new claim 20 which properly recites "A method of treating a disease or condition requiring allograft transplantation". It is therefore believed that claims 15 and 20 are in compliance with 35 USC 112 second paragraph. Withdrawal of the rejection is respectfully requested.

In view of the above amendments and remarks, applicants request favorable reconsideration and early allowance of claims 1-3, 7,13-20 . If the Examiner believes that a telephone discussion would be helpful in expediting allowance of this application, the Examiner is invited to call the undersigned at the below listed telephone number.

Respectfully submitted,

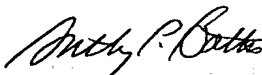
  
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on June 16, 2003

  
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